

III. Remarks/Arguments

This Response is being made to the Office Action mailed 09/29//2005. A request for a 3-month extension of time to respond has been filed concurrently herewith.

A. Formal Requirements

Applicant notes that he has complied with "all formal requirements" with respect to the pending application in accordance with 37 CFR 1.111(b) and MPEP § 707.07(a).

B. The Objection of drawings:

In the Office Action, the drawings were objected to under 37 CFR 1.83(a) as failing to show certain specific items mentioned in the dependent claims, and thus the Office Action directed that "the round elements, the sewing, gluing, heat welding, the screws, the staples must be shown or the feature(s) canceled from the claim(s). No new matter should be entered."

First, it is respectfully pointed out that the dependent claims which are drawn to these specific items were included for the purpose of "claim differentiation" in order to more fully point out and demonstrate that the scope of this invention as claimed in the independent claims is not limited to the specific embodiments shown, and thus should not be interpreted to be limited to any particular means by which the braided elements are attached to the base or to any particular cross-sectional shape of the individual strands of the braids. *Phillips v. AWH Corp*, 415 F.3d 1303, 1314-15, 75 USPQ2d 1321 (Fed.Cir. 2005)(" Differences among claims can also be a useful guide in understanding the meaning of particular claim terms. See *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed.Cir.1991). For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim. See *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed.Cir.2004)"). Indeed, in Claims 1 and 16 as filed and an amended here, it is clearly intended by the Applicant that his invention is not so limited, and extends to any means of attachment and to any cross-sectional shape of the individual strands of the braid, be they perfectly round, perfectly flat or anything in between. Accordingly, none of those elements is "essential for a proper understanding of the invention."

Second, because those elements are not essential, specific depiction of them in the drawings is not required by 37 C.F.R. §1.83. Indeed, it would be practically impossible to list in

the specification and depict in the drawings every single attachment mechanism or means that could be employed for attaching the braided element to the base, from sewing, to staples, to rivets, to bolts, to brackets, to screws, etc., or to depict every single possible cross-sectional shape of the individual wires used in the braided elements. It is precisely for these situations that the provisions of 37 CFR §1.83(a) are limited only to those elements that are "essential for a proper understanding of the invention." As none of the items to which the Office Action refers are such, the objection to the drawings is not believed to be correct.

If, on the other hand, the Examiner would nonetheless like to have some of the other specific attachment means depicted, the Applicant is willing to do so via amended drawings. Because the specification and the claims already refer to other such attachment means (and because the claims are part of the specification, *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998); *In re Benno*, 768 F.2d 1340, 1346 (Fed.Cir. 1985, opinion by Judge Rich)), such added elements in the drawings would not constitute new matter.

C. The Rejection of Independent Claims 1 and 16

The current rejection of claims 1 and 16 is the linchpin basis for the rejection of all claims. Or stated another way, if the rejection to claims 1 is overcome, each of these dependent claims also become allowable.

In the Office Action, claims 1 and 16 (and others) were rejected under 35 U.S.C. § 102(b) in view of Spooner (U.S. Patent Publication No. 2002/0092481), with the Office Action taking the view that Spooner discloses in page 2, paragraph 0021 that "the conductive element may be mesh wires which can be considered as braided wire." (Office Action, Page 3, ¶¶ 2 and 3).

It is respectfully submitted that the Office Action misreads and misapplies Spooner. The crux of the issue regarding this rejection is whether the "mesh wires" in Spooner either anticipates or renders obvious *a plurality of smaller strands braided together to form each element* as disclosed and claimed herein. If not, then the rejection of claim 1 (and of the other claims) cannot stand.

Spooner discloses a device that is essentially a non-conductive mat **2** into which conductive wires **10** are embedded in a cross-hatch fashion. Although Spooner does use the term

“mesh wiring” [paragraph 0021] when referring to this arrangement, it is *plainly* neither disclosing nor suggesting the braided element which is attached by means that will allow for flexing of the base without dislodging the wire. In this regard, when Spooner uses the term “mesh” he is doing so in an entirely different connotation, as in “any arrangement of interlocking metal links or wires with evenly spaced, uniform small openings between” [Webster’s Encyclopedic Unabridged Dictionary, 2001]. In other words, as in a “net” or “netting.” That is the manner in which Spooner uses the term “mesh” because that is exactly what he is describing – a wire net that is embedded in the mat. To underscore this point, and to make even more clear that Spooner’s “mesh” does not disclose, teach or suggest the braided conductive element in the instant application, it is noted that where Spooner uses the term “mesh” he refers to what is shown in Figure 3, and Figure 3 is a cross-sectional view that shows single, solid wires residing within channels within the mat. Nothing in Figure 3 even relates to, much less discloses or teaches, the inventive concept claimed here.

As the Federal Circuit has repeatedly instructed, when there are multiple dictionary definitions for a term under consideration, the definition that applies most aptly in the context of the intrinsic record:

"Our precedent referencing the use of dictionaries should not be read to suggest that abstract dictionary definitions are alone determinative. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor. 'Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.'"

Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 326 F.3d 1215, 1221-22, 66 U.S.P.Q.2d 1517 (Fed. Cir. 2003). *See also, Phillips v. AWH Corp.*, 415 F.3d at 1319 ("[B]ecause words often have multiple dictionary meanings, the intrinsic record must be consulted to determine which of the different possible dictionary meanings is most consistent with the use of the term in question by the inventor"). Here, it is clear that Spooner did not intend “mesh wire” in the context that was adopted and used in the Office Action as the basis for rejection.

It is also interesting to note that Figure 3 shows no attachment mechanism between the wire and the mat—the wire simply lies loosely within a channel. This works fine in the Spooner device because it is intended to always lie flatly on the ground, and thus is intended for a much more limited use than the invention at issue here. There is simply nothing in Spooner that discloses, teaches or suggests the invention here.

Therefore, it is clear that Spooner neither anticipates nor makes the device of this invention obvious. Accordingly, claim 1 in its prior iteration adequately distinguished over the reference to Spooner. However, so as to move this case and all pending claims to issue, Claim 1 has been amended slightly so as to refer to an electric deterrent device in which a base and a pair of electricity conducting elements attached to the base both can be bent and that when the base is bent in convex flex the compression stress placed on the braided elements is absorbed by individual strands. It is beyond peradventure that the device disclosed and suggested in Spooner has absolutely no capability to perform this.

Once the rejection to Claim 1 is removed, then all of the following currently rejected claims become allowable.

D. The Rejection of Claim 16 and Claims depending therefrom:

These claims were rejected on the same basis as was claim 1, as claim 16 differs only slightly from claim 1. The Remarks above apply equally to claim 16 as well. Claim 16 has been amended slightly. It is respectfully requested that the rejection of these claim 16 and claims depending therefrom be withdrawn.

E. Claims Rejections - 35 USC § 103

The rejection of claims under 35 USC §103 is also based on Spooner, and thus the comments above apply equally here.

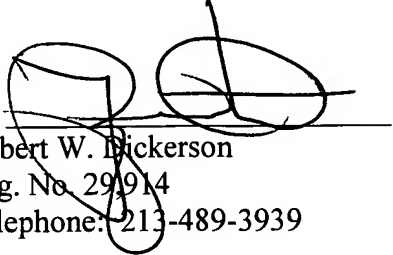
In sum, all of the independent claims in the listing above are patentable, and thus are the various claims depending from them.

WHEREFORE, Applicant respectfully requests that a Notice of Allowance of all pending claims be issued in this case. If the examiner believes a telephone interview would be helpful, such a call would be welcomed.

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Respectfully submitted,

JONES DAY

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